

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/732,701
ATTORNEY DOCKET NO. Q62251

REMARKS

Applicant thanks the Examiner for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on February 27, 2001, thereby confirming that the listed references have been considered.

Applicant has submitted a certified copy of the priority document, Japanese Patent Application No. Heisei 11-351657, to the U.S. Patent and Trademark Office on January 7, 2003. Applicant requests that the Examiner indicate receipt of same in the next Communication from the Patent Office.

Claims 1-27 have been examined on their merits.

The Examiner objects to claims 5-8, 11, 13-15, 18-20 and 23-25 as being dependent upon a rejected base claim. Applicant thanks the Examiner for indicating that claims 5-8, 11, 13-15, 18-20 and 23-25 would be allowed if rewritten in independent form. Applicant herein cancels claims 1, 4, 9, 10, 12, 17 and 22 without prejudice and/or disclaimer. Applicant herein rewrites claims 5, 6 and 7 in independent form, each including the recitations of cancelled claims 1 and 4. Applicant herein rewrites claim 11 in independent form with the recitations of cancelled claim 10. Applicant herein rewrites claim 13 in independent form with the recitations of cancelled claims 1 and 12. Applicant herein rewrites claim 18 in independent form with the recitations of cancelled claims 9 and 17. Applicant herein rewrites claim 23 in independent form with the recitations of cancelled claims 10 and 22. Finally, Applicant herein rewrites claims 16, 21 and 26 in independent form. Support for the amendments to claims 16, 21 and 26 can be found at

Sheet { page 14, lines 3-11 and page 21, lines 6-15. Entry and consideration of the claim amendments is respectfully requested.

Claims 3 and 8 have been editorially amended for reasons of precision of language. The amendments to claims 3 and 8 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 3 and 8 were not made for reasons of patentability.

Claims 2, 3, 5-8, 11, 13-16, 18-21, 23-27 are all the claims presently pending in the application.

1. Claims 1, 3, 4, 10, 12, 22 and 26 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Texture Image Retrieval by Universal Classification for Wavelet Transform Coefficients*, Proceedings on Image Processing (1997) by Yue *et al.* The rejection of claims 1, 4, 10, 12 and 22 is now moot due to their cancellation. Applicant traverses the rejection of claims 3 and 26 for at least the reasons discussed below.

Applicant has rewritten claim 5 in independent form and has amended claim 3 to now depend from claim 5, instead of from claim 1. The Examiner has indicated that claim 5 would be allowable if rewritten in independent form. See October 6, 2003 Non-Final Office Action, page 9, numbered paragraph 7. Applicant submits that claim 5 is now in condition for allowance, and further submits that claim 3 is in condition for allowance as well, at least by virtue of its dependency from claim 5.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Yue *et al.* disclose, *inter alia*, that two separate images undergo wavelet transformation, and the individual statistics of the image sub-bands are compared to reach an image discrimination value. This discrimination value is indicative of the similarity of the images being compared to each other. See, e.g., page 221, col. 3-4; Figure 1 of Yue *et al.* In contrast, the invention recited in claim 26 produces a discrete cosine transform coefficient by performing a discrete cosine transform on an entire resized image and then uses the coefficient as an extracted first group of image feature descriptors. There is no teaching or suggesting in Yue *et al.* of the production of discrete cosine transform coefficients based on an entire resized image.

Based on the foregoing reasons, Applicant submits that Yue *et al.* fails to disclose all of the claimed elements as arranged in claim 26. Therefore, under *Hybritech* and *Richardson*, Yue *et al.* clearly cannot anticipate the present invention as recited in independent claim 26. Thus,

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Applicant submits that claim 26 is allowable, and respectfully requests that the Examiner withdraw the § 102(b) rejection of claim 26.

2. Claims 1-4, 10, 12, 16, 22, 26 and 27 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lee (U.S. Patent No. 6,345,275). The rejection of claims 1, 4, 10, 12 and 22 is now moot due to their cancellation. Applicant traverses the rejection of claims 2, 3, 16, 26 and 27 at least for the reasons discussed below.

Applicant has rewritten claim 5 in independent form and has amended claims 2 and 3 to now depend from claim 5, instead of from claim 1. The Examiner has indicated that claim 5 would be allowable if rewritten in independent form. *See* October 6, 2003 Non-Final Office Action, page 9, numbered paragraph 7. Applicant submits that claim 5 is now in condition for allowance, and further submits that claims 2 and 3 are in condition for allowance as well, at least by virtue of their dependency from claim 5.

check { Applicant has amended claim 27 to recite similar features as new independent claim 18. The Examiner has indicated that claim 18 would be allowable if rewritten in independent form. *See* October 6, 2003 Non-Final Office Action, page 9, numbered paragraph 7. Applicant submits that claim 27 is now allowable for at least the same reasons as newly independent claim 18.

Applicant respectfully requests that the § 102(e) rejection of claim 27 be withdrawn.

{ With respect to claims 16 and 26, Lee discloses, *inter alia*, extracting a feature vector of each sub-block of a normalized image. *See, e.g.*, claim 1 of Lee. In contrast, the invention recited in claims 16 and 26 produces a discrete cosine transform coefficient by performing a

discrete cosine transform on an entire resized image and then uses the coefficient as an extracted first group of image feature descriptors. There is no teaching or suggestion in Lee of using the entire resized image for producing a discrete cosine transform coefficient.

Based on the foregoing reasons, Applicant submits that Lee fails to disclose all of the claimed elements as arranged in claims 16 and 26. Therefore, under *Hybritech* and *Richardson*, Lee clearly cannot anticipate the present invention as recited in independent claims 16 and 26. Thus, Applicant submits that claims 16 and 26 are allowable, and respectfully requests that the Examiner withdraw the § 102(e) rejection of claims 16 and 26.

3. Claims 2, 9, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yue *et al.* The rejection of claims 9 and 17 is now moot due to their cancellation. Applicant traverses the rejection of claims 2 and 27 at least for the reasons discussed below.

Applicant has rewritten claim 5 in independent form and has amended claim 2 to now depend from claim 5, instead of from claim 1. The Examiner has indicated that claim 5 would be allowable if rewritten in independent form. See October 6, 2003 Non-Final Office Action, page 9, numbered paragraph 7. Applicant submits that claim 5 is now in condition for allowance, and further submits that claim 2 is in condition for allowance as well, at least by virtue of its dependency from claim 5.

check Applicant has amended claim 27 to recite similar features as new independent claim 18. The Examiner has indicated that claim 18 would be allowable if rewritten in independent form.

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See October 6, 2003 Non-Final Office Action, page 9, numbered paragraph 7. Applicant submits that claim 27 is now allowable for at least the same reasons as newly independent claim 18.

Applicant respectfully requests that the § 103(a) rejection of claim 27 be withdrawn.

4. Claims 9, 17 and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lee. The rejection of claims 9 and 17 is now moot due to their cancellation. Applicant traverses the rejection of claim 21 at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Lee discloses, *inter alia*, extracting a feature vector of each sub-block of a normalized image. *See, e.g.*, claim 1 of Lee. In contrast to the present invention, however, Lee fails to teach or suggest performing a discrete cosine on an entire resized image to produce a discrete cosine transform coefficient and then using the coefficient as an extracted first group of image feature descriptors. There is no teaching or suggestion in Lee of using the entire resized image for producing a discrete cosine transform coefficient. Thus, Applicant submits that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

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Based on the foregoing reasons, Applicant submits that Lee fails to disclose all of the claimed elements as arranged in claim 21. Applicant submits that claim 21 is allowable, and respectfully requests that the Examiner withdraw the § 103(a) rejection of claim 21.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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